UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,991	04/16/2004	Sebastian Janssen	237310-000002	8735

84310 7590 10/06/2010

Troutman Sanders LLP
The Chrysler Building
405 Lexington Avenue
New York, NY 10174

EXAMINER
WONG, ERIC TAK WAI

ART UNIT	PAPER NUMBER
3693	

NOTIFICATION DATE	DELIVERY MODE
10/06/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Ellen.Walters@troutmansanders.com
patents@troutmansanders.com
james.schutz@troutmansanders.com

Office Action Summary	Application No.	Applicant(s)	
	10/825,991	JANSSEN, SEBASTIAN	
	Examiner	Art Unit	
	ERIC T. WONG	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 July 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *7,9-14 and 16-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7, 9-14, and 16-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 7, 9-14, and 16-22 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for estimating market value at the level of an individual insured by dividing the aggregate contract market value by the number of individual insured, does not reasonably provide enablement for any other means for estimating market value at the level of an individual insured. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

> Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. In re Wands, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). A patent

need not teach, and preferably omits, what is well known in the art. In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); Hybritech, Inc. v. Monoclonal Antibodies , Inc ., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). >Any part of the specification can support an enabling disclosure, even a background section that discusses, or even disparages, the subject matter disclosed therein. Callicrate v. Wadsworth Mfg., Inc., 427 F.3d 1361, 77 USPQ2d 1041 (Fed. Cir. 2005)(discussion of problems with a prior art feature does not mean that one of ordinary skill in the art would not know how to make and use this feature).< Determining enablement is a question of law based on underlying factual findings. In re Vaeck, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); Atlas Powder Co. v. E.I. du Pont de Nemours & Co., 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984).

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

(A) The breadth of the claims;
(B) The nature of the invention;
(C) The state of the prior art;
(D) The level of one of ordinary skill;
(E) The level of predictability in the art;
(F) The amount of direction provided by the inventor;
(G) The existence of working examples; and
(H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) (reversing the PTO's determination that claims directed to methods for detection of hepatitis B surface antigens did not satisfy the enablement requirement). In Wands, the court noted that there was no disagreement as to the facts, but merely a disagreement as to the interpretation of the data and the conclusion to be made from the facts. In re Wands, 858 F.2d at 736-40, 8 USPQ2d at 1403-07. The Court held that the specification was enabling with respect to the claims at issue and found that "there was considerable direction and guidance" in the specification; there was "a high level of skill in the art at the time the application was filed;" and "all of the methods needed to practice the invention were well known." 858 F.2d at 740, 8 USPQ2d at 1406. After considering all the factors related to the enablement issue, the court concluded that "it would not require undue experimentation to obtain antibodies needed to practice the claimed invention." Id., 8 USPQ2d at 1407. It is improper to conclude that a disclosure is not enabling based on an analysis of only

> one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407. A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). The determination that "undue experimentation" would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a conclusion reached by weighing all the above noted factual considerations. In re Wands, 858 F.2d at 737, 8 USPQ2d at 1404. These factual considerations are discussed more fully in MPEP § 2164.08 (scope or breadth of the claims), § 2164.05(a) (nature of the invention and state of the prior art), §2164.05(b) (level of one of ordinary skill), §2164.03 (level of predictability in the art and amount of direction provided by the inventor), § 2164.02 (the existence of working examples) and § 2164.06 (quantity of experimentation needed to make or use the invention based on the content of the disclosure).

3. Regarding claim(s) 7, 13, and 19, based upon consideration of all of the relevant factors with respect to the claim(s) as a whole, the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The rationale for this finding is explained below:

4. The specification, while being enabling for estimating market value at the level of an individual insured by dividing the aggregate contract market value by the number of individual insured, does not reasonably provide enablement for any other means for estimating market value at the level of an individual insured.

5. The examples in the specification are limited to a single scenario, ie. tracking market value at the individual insured level in one of the most simplistic situations, where the individual insureds are identical. Applicant agrees (see pg. 7 of Remarks filed 7/19/2010). A single working example (or scenario) in the specification for a claimed invention is enough to preclude

a rejection which states that nothing is enabled since at least that embodiment would be enabled. However, a rejection stating that enablement is limited to a particular scope may be appropriate. The presence of only one working example should never be the sole reason for rejecting claims as being broader than the enabling disclosure, even though it is a factor to be considered along with all the other factors. To make a valid rejection, one must evaluate all the facts and evidence and state why one would not expect to be able to extrapolate that one example across the entire scope of the claims (see MPEP 2164.02).

6. Analysis of the following factors support a determination that the disclosure does not satisfy the enablement requirement commensurate in scope with the claims:

(A) The breadth of the claims

The claims recite applying an assessment to an estimated market value at the level of an individual insured. However, the claims do not recite how the market value is estimated.

(C) The state of the prior art

The prior art does not teach estimating market value at the level of an individual insured. Instead, the prior art only teaches tracking market value at the contract level. Market values of stable value investment products are only known at the contract level because that is the manner in which they are traded, ie. only aggregate contracts are available on the market.

(D) The level of one of ordinary skill

One of ordinary skill in the art would not know how to estimate market value at an individual insured level since traditionally only aggregate contracts are traded on the market.

(E) The amount of direction provided by the inventor

The examples in the specification are limited to tracking market value at the individual insured level in one of the most simplistic situations, where the individual insureds are identical. Applicant agrees (see pg. 7 of Remarks filed 7/19/2010). In this scenario, the estimated market value of an individual insured appears to be obtained by dividing the aggregate contract market value by the number of individual insureds. For example, referring to Table 4 on pg. 7 of the specification, there are 10 identical insureds with an aggregate contract value of $900. Thus, each individual insured has an estimated market value of $900 / 10 = $90.

Applicant even admits that in certain instances, the market value of the traditional stable value fund cannot be explicitly assigned to the individual insured in consistent manner (see paragraph 6 of Specification).

(G) The existence of working examples

Applicant agrees that examples in the Specification illustrate tracking both stable and market values at the individual insured level in one of the most simplistic situations, where the individual insureds are identical (see pg. 7 of Remarks filed 7/19/2010).

A search of the prior art yielded no further examples of estimating market value at the individual insured level.

7. Based on the analysis of the factors above, Examiner concludes that the scope of enablement provided by the disclosure is not commensurate with the scope of protection sought by the claims.

Response to Arguments

8. Applicant's arguments filed 7/19/2010 have been fully considered but they are not persuasive.

9. Applicant argues that to perform the calculations recited by the independent claims, one need not divide the aggregate contract market value by the number of individual insureds (see pg. 7 of Remarks filed 7/19/2010). The fact that, in the given examples, the market value can be verified by dividing the aggregate contract market value by the number of individual insureds in no way indicates that this is the manner in which the claimed invention determines market values for individual insureds. To the contrary, the fact that verification can be performed in this manner further illustrates why identically-insured situations were selected as examples, because in these situations, the calculations can be easily verified as providing the desired results.

10. The argument is not persuasive for the following reasons:

11. It may be true that to perform the calculations recited by the independent claims, one need not divide the aggregate contract market value by the number of individual insureds.

However, to perform the calculations recited by the independent claims, one DOES need to track market value at the individual insured level. As discussed above in the rejection of the claims, the specification only provides one way of doing this. The examples in the specification are limited to tracking market value at the individual insured level in one of the most simplistic situations, where the individual insureds are identical. Applicant agrees (see pg. 7 of Remarks filed 7/19/2010). In this scenario, the estimated market value of an individual insured appears to be obtained by dividing the aggregate contract market value by the number of individual insureds. For example, referring to Table 4 on pg. 7 of the specification, there are 10 identical insureds with an aggregate contract value of $900. Thus, each individual insured has an estimated market value of $900 / 10 = $90. In addition to the specification only teaching one way of estimation, given the state of the prior art and the level of one of ordinary skill, one of ordinary skill in the art at the time of invention would not know how to perform the estimation in any other way without further direction. Applicant even admits that in certain instances, the market value of the traditional stable value fund cannot be explicitly assigned to the individual insured in consistent manner (see paragraph 6 of Specification).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC T. WONG whose telephone number is 571-270-3405. The examiner can normally be reached on Monday-Friday 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

ERIC T. WONG
Examiner
Art Unit 3693

September 27, 2010